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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. 949

KAISER INDUSTRIES CORPORATION, VEREINIGTE OESTERREICHISCHE EISEN-UND STAHLWERKE AKTIENGESELLSCHAFT, and BRASSERT OXYGEN TECHNIK AG., Petitioners,

v.

McLOUTH STEEL CORPORATION, Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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KAISER INDUSTRIES CORPORATION, VEREINIGTE OESTERREICHISCHE EISEN-UND STAHLWERKE AKTIENGESELLSCHAFT, and BRASSERT OXYGEN TECHNIK AG., Petitioners,

v.

McLOUTH STEEL CORPORATION, Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

To The Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioners, Kaiser Industries Corporation (Kaiser), Vereinigte Oesterreichische Eisen-und Stahlwerke Aktiengesellschaft (VOEST), and Brassert Oxygen Technik AG. (BOT), respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in this case on August 2, 1968.

Jurisdiction.

THE OPINIONS BELOW.

The opinion of the United States District Court is reported at 257 F. Supp. 372. It is printed in Appendix A to this petition at pages 45a to 204a. The opinion of the Court of Appeals for the Sixth Circuit is reported at 400 F. 2d 36. It is printed in Appendix A at pages 1a to 43a.*

JURISDICTION.

The judgment of the Court of Appeals (App. A, p. 43a) was entered on August 2, 1968. A timely petition for rehearing was filed on August 26, 1968 (the time for filing the petition having been extended by the Court). The petition for rehearing was denied on September 10, 1968 (App. A, p. 44a). The time for filing this petition was extended by this Court to January 16, 1969 by an order entered November 26, 1968. The jurisdiction of this Court is invoked pursuant to 28 U.S.C., Section 1254(1). The basis for jurisdiction in the District Court is 28 U.S.C., Section 1338 (a), and the fact that the case is an infringement action arising under the Patent Laws of the United States.

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*The Appendices to this Petition are printed separately because of the length of the Opinions below.

QUESTIONS PRESENTED.

The Suess et al. patent in issue in this action is addressed to the famous L-D or basic oxygen steelmaking process invented in Austria.

The L-D process has concededly revolutionized the steelmaking art throughout the world. In this country alone, it has saved steelmakers billions of dollars. It has rendered obsolete existing steelmaking processes. Within a reasonable period of time, as new steelmaking facilities are constructed to replace existing equipment, the L-D process will surely become the almost universally accepted method for making steel.

The District Court held that the L-D process was novel, useful and unobvious to those skilled in the art. Further, the District Court found that the gist of the invention — the avoidance of deep penetration of the oxygen jet into the molten metal bath — was adequately disclosed in the specification of the patent in suit. The District Court held, however, that the language in the claims used to define the concept of avoidance of deep penetration did not define that concept. Therefore, the District Court concluded that the patent was invalid for failure of the claims to define the invention.

In affirming the decision of the District Court, the Court of Appeals held that the language in the claims did not define the invention claimed to be patentable.

Finally, both courts invoked the file wrapper estoppel doctrine to defeat the patent in suit, although the applicability of that doctrine was never raised or briefed by respondent in either court.

Questions Presented.

The questions presented by the decisions below are as follows:

1. Did the courts below apply the proper legal standards for determining whether the claims adequately defined the invention when both courts refused to use as aids in construing the language of the claims both the file wrapper history and the specification of the patent in suit?

2. Did the courts below correctly apply the file wrapper estoppel doctrine to defeat the patent in suit when (a) there was no evidence that the applicants intended to abandon claims adequately defining their invention, (b) the file wrapper history showed affirmatively that the applicants continued to claim the real "gist" of their invention at the time the alleged abandonment took place, (c) the differences between the claims as allowed and as earlier presented consisted of mere changes of expression intended and represented to have the same meaning, and (d) the changes in words were accepted by the Patent Office as defining the real "gist" of the invention, *i.e.*, the applicants' new concept.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED.

The questions presented involve Article I, Section 8, Clause 8, of the Constitution, which provides that the Congress shall have power

> "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

They also involve Sections 112 and 282 of the Patent Code of 1952 (35 U.S.C., §§ 112, 282), which, in pertinent part, read as follows:

Section 112:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. * * *
>
> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding struc-

ture, material, or acts described in the specification and equivalents thereof."

Section 282:

"A patent shall be presumed valid. * * * The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it."

STATEMENT OF THE CASE.

This case involves far-reaching and significant issues affecting the steel industry in the United States and the proper construction of the patent laws of the United States, which should be considered by this Court.

The decisions below, we respectfully submit, have subverted the underlying goals and purposes of the patent laws, *i.e.*, "to bring forth new knowledge,"* by striking down a patent on a meritorious invention of great utility. The courts below acted in a fashion contrary to applicable decisions of this Court by refusing to apply liberal rules of construction to determine the meaning of language used in the claims of the patent in suit. Instead, the courts below applied rigid rules of construction which place an unfair premium on draftsmanship to the detriment of substantial rights and which turn the patent laws into a game of words.

The net effect of the decisions below has been to strike down a patent on what is concededly a revolutionary steelmaking process by strictly construing and placing an admittedly "meaningless" construction on the claims of the patent in suit and by disregarding the meaning given to the claims by the specification and file wrapper history.

This Court should review the decision of the Court of Appeals to correct the errors below and to guarantee that the patent laws will be administered in a fashion which protects, instead of defeats, valuable property rights in a significant invention of great utility.

**Graham v. John Deere Co.*, 383 U.S. 1, 9 (1966)

Statement of the Case.

A. The Nature of the Action.

This is an action charging an avowed copyist, McLouth Steel Corporation, with infringement upon the Suess et al. patent No. 2,800,631, granted July 23, 1957 (App. B, pp. 207a-212a).

Petitioner, VOEST, is a "steel company owned by the Austrian Government" (App. A, p. 3a). It is the owner of the patent. Petitioner, BOT, is a Swiss corporation, which is jointly owned by VOEST and Oesterreichisch-Alpine Montangesellschaft (OAM), another Austrian steel company which is part of Austria's nationalized industry. BOT holds exclusive worldwide licensing rights. Petitioner, Kaiser, holds exclusive licensing rights in the United States which it purchased from BOT. The respondent, McLouth, is a steelmaker having a plant at Trenton, Michigan, where it practices the L-D process taught to it by Kaiser and the Austrians.

McLouth heard of this new L-D steelmaking process and decided "to integrate the Austrian process into" its operations (App. A, p. 66a). The design of the equipment and the entire operation were "copied from the one at Linz" (App. A, p. 66a).

In the District Court, McLouth initially asserted that it had acquired a paid-up license to use the invention by reason of a technical assistance agreement it entered into with Kaiser. That issue was tried first, and both the District Court and the Court of Appeals held that McLouth did not obtain license rights under that agreement (175 F. Supp. 743; 277 F. 2d 458).

McLouth continued the battle, asserting non-infringement and invalidity. The District Court pointed out (App. A, p. 68a) that while McLouth denied "infringing the process as stated in the claims of the patent" it did "not contest the allegation that it is using the process disclosed by the specification" and used by all others. In this connection, the District Court held (App. A, p. 68a):

> "Defendant admits that the process disclosed in the specification of the Suess patent in suit is the same as the process in use at the VOEST plant in Linz, Austria. * * * Defendant further admits that the Linz process is essentially the same as the process in use at the McLouth plant * * * . * * * on final argument, counsel for defendant stated: 'We do not contest that basically, fundamentally, the Linz process, as practiced, and the McLouth process — and I may add every other oxygen blowing process of which we have any knowledge — follows the same general method.' * * * and in its reply brief, defendant stated: 'McLouth has never contested the fact that all oxygen blowing of a practical or commercial nature — and the "exemplary commercial practice" of the patent is understood to be the Linz practice — is basically similar.' "

B. The Origin and Nature of the Invention.

The L-D or basic oxygen steelmaking process disclosed in the patent has revolutionized steelmaking throughout the world, as both courts below recognized (App. A, pp. 6a-7a, 46a, 53a, 99a, 166a-167a, 202a-203a). On this point, the District Court stated (App. A, p. 46a):

"The oxygen steelmaking process at issue in this litigation has demonstrated in recent years undoubted advantages over older methods of steelmaking, including reduction of capital and operating costs, increase of production rates, and improvement in quality of the steel produced. Therefore, perfection of the process has resulted in its large-scale adoption in the United States and throughout the world. Defendant McLouth has admitted that the new oxygen steelmaking process is 'a revolutionary method of making high quality steel.' * * * Additionally, the process has been characterized by the President of Jones & Laughlin Steel Company as 'the only major technological breakthrough at the ingot level in the steel industry since before the turn of the century.' "*

In the manufacture of steel, pig iron, which is sometimes known as "hot metal" when in the liquid state, is first produced in a blast furnace. Iron ore, coke, limestone and air are the primary materials employed in making pig iron. The product of the blast furnace contains an excess of carbon, manganese, silicon, phosphorus and sulphur which must be materially reduced by a refining or steel manufacturing process in order to provide steel having satisfactory properties. This refining of the pig iron into steel has been carried out by various processes.

The Bessemer process came into being about 1856. The acid Bessemer process came first. In this process, hot metal and at times a small amount of scrap are

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*The growth and magnitude of the process are shown in PX-82, PX-83 and PX-104 (App. B, pp. 261a-270a).

charged into a converter and air or oxygen-enriched air is blown upwardly through holes in the bottom of the vessel. This was the principal refining process for many years. It was unsatisfactory for most pig irons because phosphorus and sulphur could not be removed. Also, the product was high in objectionable nitrogen. The Thomas or basic Bessemer process was devised about 1879 to permit the use of a basic slag capable of removing phosphorus by means of an afterblow. This process proved unsatisfactory because of excessive nitrogen developed in the steel (App. A, p. 5a).

The open hearth method of refining steel came into being shortly before the turn of the century and has been the principal method of refining pig iron into steel. As late as 1953, approximately 89 percent of the steel produced in the United States came from open hearth furnaces. This process produces satisfactory steel; but, as the Court of Appeals found, it "has the disadvantage of high capital and operating costs and a relatively slow rate of production" (App. A, p. 6a). The average open hearth heat requires 8 to 10 hours, as compared with approximately 40 minutes in the L-D process.

Prior to the advent of the L-D process, there were many efforts made by highly skilled men extending over decades attempting to solve the problem of how to use oxygen as the sole refining agent to make steel. All of these efforts failed to provide a commercially successful process.

Bessemer, over a hundred years ago, suggested the use of oxygen instead of air for refining pig iron into steel. Nothing came of this suggestion. In 1928, the invention of the Linde-Fraenkl process for producing

oxygen cheaply in tonnage quantities created the possibility of using pure oxygen in the commercial refining of pig iron into steel (App. A, p. 51a). In the 1930's, efforts to solve the problem of using oxygen in refining pig iron into steel were made by many highly skilled men (App. A, p. 51a). They all failed, as respondent's witness Dr. Durrer admitted (App. A, p. 51a). In the early 1940's, further efforts, including both bottom blowing and top blowing operations, were made by others (App. A, pp. 49a, 51a-52a). They failed. Dr. Durrer and Dr. Hellbruegge, in the late 1940's, tried, and they failed (App. A, pp. 23a, 51a-52a, 72a-73a, 128a-136a).

In the Bessemer process in which air is blown upwardly into the bath through the bottom and in the experimental bottom blowing and top blowing work, the fundamental concept was that it was essential to get the gas as deep into the molten metal bath as possible without injuring the refractories so as to physically agitate or stir the bath with the air or oxygen stream (App. A, pp. 50a-53a, 71a-72a, 79a-85a; App. B, pp. 219a, 230a). The best of the top blowing prior art, Schwarz and Miles, taught this; and Dr. Durrer and Dr. Hellbruegge as late as 1948-49 knew no better than to follow that concept (App. A, pp. 118a-122a). And the harder one tries to follow Miles, Schwarz and the Durrer-Hellbruegge teachings of a deeply penetrating jet to obtain agitation or stirring of the bath by the jet, the greater the failure because of refractory damage and inability to get iron oxide into the slag to create an early fluid slag capable of removing phosphorus—an absolute necessity.

The Austrian inventors were thoroughly experienced in the steel industry and knew of the work and failures of their predecessors. Nevertheless, they undertook the solution of "this great problem" of utilizing high purity oxygen for refining pig iron into steel. At the outset, they tried to follow the Durrer-Hellbruegge teachings. An accident occurred in the early stages of this work which caused extensive discussions and produced the thought that satisfactory refinement might be obtained if the impact pressure of the jet of oxygen on the molten bath was reduced so that the jet did not penetrate deeply into the bath. Controlled and comparative tests were performed which demonstrated that success was obtained only when the oxygen was blown substantially vertically downwardly onto the center of the surface of the bath so as to *avoid deep penetration* of the oxygen jet into the bath and stir or circulate the bath by *chemical reactions* instead of by the mechanical action of the jet (App. B, pp. 221a-224a, 226a-228a). Further tests were made thereafter.

Approximately 250 tests were made during this experimental and development program, after which the first commercial basic oxygen steelmaking operation in the history of the world came into being at Linz, Austria, in November, 1952.

Succinctly stated, the new concept of the patentees was that by avoiding deep penetration and the agitation of the bath caused thereby they could get the fluid slag necessary for phosphorus removal and that the circulation or stirring of the bath, which the prior workers thought had to be caused by the physical action of a deeply penetrating jet, could be obtained by chemical

reactions. They found that by utilizing a small or "intermediate" penetration, *i.e.,* sufficient penetration to avoid dangerous slopping, not so deep as to adversely affect the refractories and not so deep as to prevent iron oxide from going into the slag to provide the necessary phosphorus removal, steel of high quality could be obtained.* This is the concept which the District Court held (App. A, pp. 105a-106a, 108a-109a, 166a) to be the "gist" of the "patentable advance" made by the patentees and which they attempted to define by the claim language ["onto and below the surface * * * to an extent to avoid material agitation of the bath by the oxygen stream"] which the courts below said was "meaningless" but which the Patent Office accepted.

After these skilled Austrian steelmakers solved this "great problem," respondent's witness, Dr. Durrer, stated that their work "contradicts all metallurgical expectations" and "shows a new metallurgy with which we must first of all become acquainted" (App. A, p. 142a).

This fundamental, new concept of avoidance of deep penetration of the oxygen jet into the bath of molten metal is contrary to the teachings of the prior art that you must penetrate deeply and thereby stir or agitate the bath by the oxygen jet. It was unobvious to those skilled in the art (as the District Court held) and resulted in a completely new steelmaking process.

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*PX-332, 351F and 353 (App. B, pp. 255a-259a) show the penetration in McLouth's operations. PX-332 and PX-351F, respectively, illustrate penetration at various times in a heat, with and without consideration of the effect of slag. PX-353 is a table which covers a number of heats.

C. The Tremendous Impact of the Invention on Steelmaking Throughout the World.

The L-D process described in the patent in suit is being practiced throughout the world (App. A, pp. 6a, 46a). In the United States alone, annual L-D steelmaking capacity jumped from nothing at the beginning of 1955 to about 32 million tons by January 1, 1966 and, as of the present time, is about 56 million tons.* The annual capacity for L-D steelmaking worldwide has jumped from approximately one-half million tons in 1953 to 110 million tons in 1966, and presently is about 220 million tons. The process, throughout the world, is replacing the old processes to a phenomenal extent. No new open hearth shops have been built in this country since about 1953. More than 75 percent of all new steelmaking facilities installed throughout the world since 1954 are L-D process installations. Sixteen steel companies in the United States have adopted the process; and in other parts of the world, 64 companies in 23 countries have installed the new process (App. A, pp. 6a-7a, 53a, 99a; App. B, pp. 265a-270a).

In the United States, licenses have been granted to a number of substantial producers, *i.e.*, Acme (Interlake), Armco, Kaiser Steel, Allegheny Ludlum, J. & L. and Alan Wood (App. A, p. 53a). Throughout the world, there are 76 companies in 20 countries which have been licensed to use the process.

The advantages and accomplishments of the invention are tremendous. The capital cost for a ton of annual capacity for the oxygen steelmaking process is

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*Total annual production in the United States by all processes is approximately 130 million tons.

about $15, as compared with about $40 per ton for open hearth capacity. The savings in operating costs are equally substantial, amounting to between $4 and $5 per ton. Thus, U. S. steelmakers, as of 1966, were saving over $100 million *annually* in operating costs and as of today this figure is approximately $250 million.

The increase in speed of operation is likewise striking. The whole oxygen steelmaking process takes about 40 minutes as compared with approximately 8 to 10 hours in an open hearth (App. A, p. 50a).

In the light of such facts, the courts below should have accorded the patent in suit the liberal treatment and construction to which it is entitled under the decisions of this Court.

D. The History of the Patent Applications.

The original application, filed January 16, 1951, contained clear teachings that the blowing was to be done in a manner to avoid deep penetration of the jet into the molten metal bath and to circulate the bath by the chemical reactions. That application was supplanted by a continuation-in-part application filed November 16, 1955 which eventuated into the patent in suit. This application, as the District Court held, fully discloses and teaches the new concept of the patentees (App. A, pp. 54a-63a, 78a, 100a-106a). It was claimed explicitly in the original claims. It was included in amended claims. And, as the file wrapper history (including the Rinesch and Hauttmann affidavits) shows, the new concept — the gist of the invention — was constantly asserted and never abandoned (App. B, pp. 219a-

230a). When the claims were rewritten in the amendment (App. B, pp. 214a-218a) which ultimately resulted in the allowance of the patent, the same fundamentally new concept was embodied therein. Different words were used to define that concept, but the affidavits filed at that time (App. B, pp. 219a-230a) make it crystal clear that the applicants were asserting the same new concept as that described in the specification.

The main claim of the patent in suit* states that a stream of oxygen is discharged "vertically downwardly through the slag layer onto and below the surface of the bath at the central portion thereof, *to an extent* [*i.e.*, to a depth] to avoid material agitation of the bath by the oxygen stream."** The claim further points out that the stirring or circulation of the bath is brought about by the chemical reactions as distinguished from the physical action of a deeply penetrating jet. Thus, the claim, as the file wrapper history shows so clearly, says to blow so as to avoid deep penetration of the oxygen stream into the bath. The file wrapper history, and specifically the Rinesch and Hauttmann affidavits (App. B, pp. 218a-229a), which the courts below refused to consider on this point, demonstrates that it was this concept the patentees represented to the Patent Office to be their invention, and that this is what both the Patent Office and the patentees thought was defined by the words used in the claim.

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*A copy of the patent is reproduced in Appendix B, at pages 207a-212a. Claim 1, the principal claim, is reproduced separately in Appendix B at page 213a.

**Emphasis ours except where noted otherwise.

E. The Holdings of the Courts Below.

The District Court, after listening to and analyzing all the evidence, came to the conclusion that the patentees had a meritorious invention. In this regard, the District Court stated it was "convinced * * * that the 'new mental concept' of the patentees to avoid a deep penetration of the bath by the jet was a patentable advance in the art of steelmaking," and held (1) that this "patentable advance" was not anticipated by any of the prior art, (2) that the invention was not obvious to those skilled in the art, (3) that the invention has great utility, and (4) that the invention was fully and adequately set forth in the specification so that those skilled in the art could practice it (App. A, pp. 166a-167a, 78a-79a, 80a-83a, 85a, 89a, 107a-116a, 46a, 150a, 153a-154a, 158a). However, it construed the claims as "meaningless" and "fictional" (App. A, p. 178a) and held the patent invalid for failure of the claims to comply with 35 U.S.C., Section 112. It held that the *gist* of the invention *as described in the specification and file wrapper history* was not in the claims and could not be read into the claims and that its omission caused the claims to overclaim the invention and read on the prior art. It also held, *sua sponte,* that the doctrine of file wrapper estoppel precluded construing the claims to embrace the gist of the invention. In construing the claims, it disregarded the fact that the specification and file history, as the court found, tell exactly what the invention is.

Significantly, the District Court concluded by saying (App. A, p. 202a):

> "The Court reaches its conclusion that the patent in suit is invalid reluctantly, not only be-

cause of the statutory presumption of validity but also because of the revolutionary nature of the invention disclosed in the specification. Revolutionary patents such as this one are entitled to a liberal construction."

The Court of Appeals affirmed the District Court's holding of invalidity on the grounds stated above. It also stated that it had doubts about the District Court's finding of non-obviousness, improperly relying on "subjective notions," * which were contrary to express findings of the lower court, and rejecting all objective criteria in an attempt (App. A, pp. 3a, 7a) to justify its narrow and unrealistic construction of the patent. It did not modify the District Court's finding of unobviousness; but, in its discussion, it destroyed the statutory presumption of validity on the *amazing* ground that the Schwarz patent "was not considered by the Patent Office" (App. A, p. 13a); whereas, the facts are, as shown by the file wrapper history, that it was called to the attention of the Examiner, a written argument against it was submitted, and it was referred to and distinguished in the two affidavits which brought about allowance of the patent (App. B, pp. 214a-218a, 219a-225a, 226a-230a).

The net effect of the decisions below was to deny the patent in suit the "liberal construction" mentioned by the District Court (*supra,* pp. 18-19). What the courts below did was to apply rigid standards for determining whether the *claims* described the invention, instead of using liberal standards and taking into account

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**In re Cable,* 347 F. 2d 872, 878 (CCPA 1965); *Allen v. Standard Crankshaft & Hydraulic Co.,* 323 F. 2d 29, 34 (4th Cir. 1963).

the file wrapper history and the specification as aids in construing the language in the claims.

The end result of the decisions below was to turn the patent laws into a game of words or a "game of skill in which one misstep by counsel may be decisive to the outcome": *Conley v. Gibson,* 355 U.S. 41, 48 (1957).

ARGUMENT AND REASONS FOR GRANTING THE WRIT.

I. The Lower Courts' Construction of the Claims Is Contrary to Established Standards and Grossly Unfair.

It seems clear that the errors of the courts below resulted from the application of erroneous standards for construing the language used in the claims. Both courts failed to accord the patent the liberal treatment to which it is entitled as a result of the magnitude of the patentees' contribution to the useful arts. Both courts *refused* to look to the file wrapper history in conjunction with the specification to aid in construing the language in the claims.

The decisions below raise substantial problems for the administration of the patent laws by placing an extremely high premium on draftsmanship. In effect, a patentee will be deprived of the fruits of his invention if the words he uses to claim his invention depart from the rigid standards of draftsmanship required by the decisions below, even though the entire history of the patent application clarifies any language deficiencies existing in the claims.

This, we submit, is a problem worthy of review by this Court, particularly in the circumstances of this case when rigid standards have been used to deprive the patentees of their rights in an invention of great significance and utility, *i.e.,* one which has saved steelmakers and the public billions of dollars.

The decisions below make a sham of the patent laws. If they represent the public policy of the United

States, no one bringing into being a basic invention, whether from the United States or from a foreign land, would dare to face the semantic snare of our patent laws with any hope of fair treatment.

Even as to a meritorious improvement invention, this Court, in *Eibel Process Company v. Minnesota & Ontario Paper Company,* 261 U.S. 45 (1923), stated (p. 63) that it

> "* * * certainly finds no reason to withhold from the really meritorious improver, the application of the rule 'ut res magis valeat quam pereat,' which has been sustained in so many cases in this Court. *Winans v. Denmead,* 15 How. 338, 341; *Corning v. Burden,* 15 How. 265, 269; *Turrill v. Railroad Co.,* 1 Wall. 491, 510; *Rubber Co. v. Goodyear,* 9 Wall. 788, 795; *McClain v. Ortmayer,* 141 U.S. 419, 425."

In the *Eibel* case, this Court also stated (p. 63):

> "In administering the patent law the court first looks into the art to find what the real merit of the alleged discovery or invention is and whether it has advanced the art substantially. If it has done so, then the court is liberal in its construction of the patent to secure to the inventor the reward he deserves."

Instead of determining from the file wrapper history and the specification the true meaning of the expressions used in the claims and applying that construction, the courts below expressly refused to follow the rule stated by this Court in *Graham v. John Deere Co.,* 383 U.S. 1, 33 (1966) that "an invention is construed

not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office."

The District Court held (1) that the "specification * * * teaches the avoidance of deep penetration as an essential characteristic of the process of the patent," (2) that it is clear from the claims that "the language concerning avoidance of material agitation must be read with reference to penetration by the jet * * *," and (3) that the Rinesch and Hauttmann affidavits attributed a "causal connection between the avoidance of deep penetration and the existence of the features of the patent claims," including avoidance of material agitation of the bath, circulation created by chemical reactions and the localized reaction zone (App. A, pp. 78a, 105a-106a, 109a, 153a-154a, 160a, 172a). However, that court *refused* to look to the file wrapper or prosecution history in interpreting the claims, stating that one reading the patent would not be "responsible for knowing the contents of" the affidavits in the file wrapper history (App. A, pp. 176a-177a). The Court of Appeals (App. A, p. 30a) also refused to consider what it termed "affidavits submitted to the Patent Office and filed somewhere obscurely in the file wrapper history of the patent."* The Court of Appeals even said that the patent

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*As this Court knows, affidavits, and particularly affidavits which lead to the issuance of a patent, are not filed "obscurely" in the file wrapper history. The file wrapper history, which is open to the public the day the patent issues, always is referred to by anyone attempting to understand and construe the difficult language of claims.

law "does not require a prospective inventor to search so far in attempting to determine the scope of a patent and the areas left open for inventive inquiry" (App. A, p. 30a). But the law does require anyone attempting to construe and determine the scope of a patent to look to the file wrapper history, as this Court has repeatedly held.

Obviously, the important limitation in the claims of "discharging a stream of oxygen vertically downwardly * * * onto and below the surface of the bath at the central portion thereof, to an *extent* [depth] to avoid material agitation of the bath by the oxygen stream" cannot be "meaningless." It meant something to the applicants and it meant something to the Patent Office. Both were making an effort to define the invention fully and adequately (App. A, p. 158a) set forth in the specification and discussed in detail in the Hauttmann and Rinesch affidavits (App. B, pp. 219a-230a) which led to the issuance of the patent. For example, Dr. Hauttmann, in the summary paragraph of his affidavit, stated (App. B, p. 230a):

> "Inasmuch as our concept of securing purification of the entire contents of the bath mainly by the controlled circulation induced by the reaction center is just the opposite of trying to carry the oxygen to all parts of the bath by agitation produced by deep penetration, as by the methods disclosed in the Schwarz and Miles patents, and constitutes a major technical advance in the commercial manufacture of steel from crude iron, I believe that our method is patentable."

The language of the revised claim takes on a clear and definite meaning when read in the light of such language in the affidavit. When so read, avoidance of material agitation by the oxygen stream referred to in the revised claim *must* mean avoidance of the "agitation produced by deep penetration" referred to in the contemporaneous affidavit. If agitation produced by deep penetration is to be avoided, it is implicit that the cause of such agitation (deep penetration) is to be avoided. The language of the claim when so construed, therefore, clearly describes the concept of avoiding the deep penetration taught by the prior art.

The refusal of the court below to look at the exact documents which resulted in issuance of the patent and which show the meaning which both the patentees and the Patent Office attributed to the claim language is contrary to the law and grossly inequitable.*

As stated, *supra,* pages 18-19, the primary basis for the decisions of the courts below was that the claims of the patent were not sufficiently precise to meet the requirements of 35 U.S.C., § 112. In analyzing the claims and specification of the patent under §112, the courts below ignored the substance of the patent and instead, in a manner reminiscent of Baron Parke construing common law pleadings, examined in minute detail and

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*As Mr. Justice Holmes said in *Towne v. Eisner,* 245 U.S. 418, 425 (1918):

> "A word is not a crystal, transparent and unchanged, it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used."

dissected in a hypertechnical manner the terms used in the patent claims.* The Court of Appeals' construction of § 112 is inconsistent with the primary purpose of the patent laws—to provide protection for true inventions; inconsistent with decisions in other circuits; and inconsistent with established rules of patent construction.

Courts have frequently recognized that a hypertechnical and strict construction of § 112 may deny to inventors the protection the patent laws were designed to grant. In drafting patent claims inventors are frequently compelled to use language which is inherently imprecise. Claims, unlike algebraic equations, are not always susceptible to mathematical precision. Consequently, courts have been vigilant to protect against hypertechnical constructions of § 112 which frustrate the operation of the patent laws: *e.g., Georgia-Pacific Corp. v. United States Plywood Corp.,* 258 F. 2d 124, 136 (2d Cir. 1958), cert. denied 358 U.S. 884; *Jones Knitting Corp. v. Morgan,* 361 F. 2d 451 (3rd Cir. 1966). This has been particularly true with respect to pioneer patents, such as the one in this case: *e.g., Corning Glass v. Anchor Hocking Glass Corp.,* 374 F. 2d 473 (3rd Cir. 1967), cert. denied 389 U.S. 826.

Generally the courts in construing the claims have examined not only the particular terms used in the claims, but have examined these in light of the entire patent and the prosecution history in the Patent

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*It was said of Baron Parke, "His fault was an almost superstitious reverance for the dark technicalities of special pleading, and the reforms introduced by the Common Law Procedure Acts of 1854 and 1855 occasioned his resignation." Sir James Parke, 15 D.N.B. 226.

Office: *e.g., Criner v. Micro-Westco, Inc.,* 139 F.2d 681 (8th Cir. 1944). Moreover, since there is frequently a problem of achieving precision in the language of claims, the courts have established the doctrine that a patentee may define the terms he uses and that definition will govern. The patentee can be his own lexicographer. This is particularly true where the terms defined by the patentee are unusual or uncommon: *e.g., Stuart Oxygen Co. v. Josephian,* 162 F. 2d 857, 860-61 (9th Cir. 1947); *Universal Oil Products Co. v. Globe Oil & Refining Co.,* 137 F. 2d 3, 6 (7th Cir. 1943), aff'd. 322 U.S. 471 (1944); *Technograph Printed Circuits Ltd. et al. v. Bendix Aviation Corp.,* 218 F. Supp. 1, 38 (D. Md. 1963), aff'd. 327 F. 2d 497 (4th Cir. 1964), cert. denied 379 U. S. 826.

For instance, in *Application of Corr,* 347 F. 2d 578 (CCPA, 1965), the Court of Customs and Patent Appeals reversed a decision of the Patent Office Board of Appeals which had rejected the claims of a patent application as unlawfully broad and indefinite. The court stated that if the claims were read without reference to additional materials, they would in fact be unduly broad. However, the terms used in the claims were adequately defined in the specification and this definition was sufficient to dispel any uncertainty or overbreadth. The court acknowledged that the patentee could "be his own lexicographer" (347 F. 2d at 580).

This well-established rule of construction was undoubtedly known to the patentees in this case. Prior to the issuance of the patent, they supplied affidavits defining the terms in the claims and relating them to the

specification.* Contrary to the above cases, the Court of Appeals in this case refused to accept the patentees' definitions of the terms used in the claims as set forth in the affidavits. It refused to allow the patentees to define their own terms.

By refusing to accept the patentees' definition of the terms of the claims, the Court of Appeals upset the patentees' justified reliance on a well-established rule of construction. In addition, it cast grave doubt on the validity of numerous other patents drafted in reliance on that doctrine. It interpreted § 112 in a hypertechnical manner that is contrary to the primary purpose of the patent laws.

This Court should review and reverse the decision below in order to resolve the conflict between that decision, this Court's decision in the *Graham* case, *supra,* and those cases cited above and to dispel the doubt cast on other valid patents by this erroneous interpretation of §112.

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*The fact that the definition of the terms in the claims was contained in affidavits filed with the Patent Office rather than in the patent itself is of no significance. The primary purpose of §112 is to require claims sufficiently definite (1) to apprise others of what is claimed by the patent and (2) to prevent patentees from extending their monopoly to cover more than what is set forth in the specification of the patent. Each of those purposes is served as well by definitions supplied by affidavits as by definitions contained in the patent itself. The affidavits were available for anyone to examine and thus could adequately apprise others of precisely what was claimed by the patentees. In addition, the definitions could properly be invoked to limit the patentees' monopoly to precisely the invention covered by the specification.

II. The Courts Below Misconstrued and Misapplied the File Wrapper Estoppel Doctrine.

Both courts below (Judge Edwards dissenting in the Court of Appeals) invoked the doctrine of file wrapper estoppel against petitioners with the result that patent rights on a meritorious invention were declared forfeited. This result was reached in spite of the facts that there was no evidence of an intent to abandon claims defining the invention and that respondent did not assert file wrapper estoppel in the District Court, did not argue the matter in the Court of Appeals and did not at any time attempt to support the applicability of this doctrine.

How can there possibly be a file wrapper estoppel against the correct and only meaningful construction of the claims when, at the very time those claims were presented to the Patent Office, the applicants, in affidavits (App. B, pp. 219a-230a), repeatedly and forcefully pointed out that they were seeking protection on the concept of avoidance of deep penetration in the claims presented? As the District Court found, those affidavits, in fact, "attributed a causal connection between the avoidance of deep penetration and the existence of the features of the patent claims, including a localized reaction zone, the avoidance of material agitation of the bath and a circulation caused by chemical reactions" (App. A, p. 109a).

How can there be an abandonment of the concept of avoidance of deep penetration when, at the very instant the abandonment inferred by the court below allegedly took place, the applicants repeatedly said that the important feature of their new process was the

avoidance of deep penetration of the oxygen jet into the bath?

The courts below misconstrued and misapplied this oft-applied and little understood doctrine as enounced by this Court in *Smith v. Magic City Kennel Club, Inc. et al.,* 282 U.S. 784, 789-90 (1931); *Schriber-Schroth Co. v. Cleveland Trust Co. et al.,* 311 U.S. 211 (1940); *Hubbell v. United States,* 179 U.S. 77, 80, 83 (1900); and other cases cited therein. In view of the forfeiture of valuable rights under the decisions below, this Court should now make clear the scope of this doctrine.

The court below based its holding of file wrapper estoppel on abandonment of specific words, stating that the defense is established "if a phrase used in an abandoned or rejected claim is not used in a later accepted claim" (App. A, p. 40a). This is directly contrary to *Hubbell v. United States, supra,* which states that

> "* * * where the differences between the claim as made and as allowed consist of mere changes of expression, having substantially the same meaning, such changes, made to meet the views of the examiners, ought not to be permitted to defeat a meritorious claimant. While not allowed to revive a rejected claim, by a broad construction of the claim allowed, yet the patentee is entitled to a fair construction of the terms of his claim as actually granted."

The holding of the courts below would preclude rewriting of claims to better define an invention — a practice which is as old as the patent system. If one cannot change words to better define an invention and *at the same time* repeatedly say that the same concept is being redefined, under what circumstances could anyone even dare to change words? Clearly, estoppel requires abandonment of a feature, thought or concept, *i.e.,* something of substance, not mere abandonment of words.

CONCLUSION.

We earnestly submit that this petition should be granted for each of the following reasons:

1. The case is of great importance to the Austrian Government, the Austrian steel industry, BOT, Kaiser and the steel industry both here and abroad.

2. The decisions below violate principles established by this Court's prior decisions and is in conflict with decisions of other Courts of Appeals.

3. The decisions below misinterpret and misapply the file wrapper estoppel doctrine as enounced in the prior decisions of this Court.

4. The decisions below effectively make a sham of our Patent Laws and the constitutional provision on which they are based.

Respectfully submitted,

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